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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,431	10/05/2005	Reiner Hannen	23386	8948
535 7590 12/13/2007 K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900			EXAMINER ADAMS, GREGORY W	
			ART UNIT 3652	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/552,431

Applicant(s)

HANNEN ET AL.

Examiner

Gregory W. Adams

Art Unit

3652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "one aligning device (5) which comes into contact with the lower region of the item (2)" as recited in claim 1, lines 9-10 must be shown or the feature(s) canceled from the claim(s). FIGS. 1 & 3 clearly show that aligner 5 never touches stack 2, but stabilizer 8 does. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the contact surface" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 7-8, the claimed steps relate to a method of making the aligning device. The examiner advises applicant that mixing statutory classes of invention may lead to indefiniteness during claim interpretation, thus Examiner seeks clarification on the type of claim Applicant has created. See MPEP 2173.05(p). Further, the method steps in claims 7-8 resemble product-by-process limitations and have been treated as such. That is, the limitations relating to how the aligning device is formed would not be expected to impart distinctive characteristics to the apparatus claims and, moreover, when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct. See *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983); MPEP 716.01 (establishing that a statement or argument by the attorney is not factual evidence). Thus, claims 7-8 can be regarded as anticipated by the applied prior art, and the burden of proof is shifted to Applicant, not the Examiner, to show that the process of making renders the claims patentably distinct. For purposes of examination, the examiner assumed proper apparatus claiming structure in claim 8.

Claims 9-13 provide for the use of aligning an item, but the claims do not set forth any steps involved in the method/process it is unclear whether the structure recited is required by the method. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced, e.g. it doesn't begin a step with "providing" or "using" or some other **-ing** ending word that provides the active step. (Emphasis added.) Applicant is respectfully reminded that to be entitled to patentable weight in method claims, the structural limitations recited therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. See *Ex parte Pfeiffer*, 135 USPQ 31 (1961). For example, claim 9, line 8 recites "in that a deflection of the lower region of the item...is prevented by a stabilizing device" which is not the equivalent of **-providing** a stabilizing device and preventing the item projecting laterally beyond the outer counter of the transport substrate--. Thus, claims 9-13 amount to the mere claiming of a use of a particular structure. For purposes of examination the Examiner assumed proper method claiming format as best understood.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 & 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsurumaki (US 6,494,450).

With respect to claims 1, 5, 7 & 9-10 & 12, Tsurumaki discloses-

- one aligning device 88A-B, e.g. prevent mis-stacking; and
- a stabilizing device, e.g. prevents damage to incoming sheets, having a supporting surface 84, 86.

With respect to a stack of flexible material such as paper or the like on a pallet Applicant is respectfully reminded that the material or article worked upon by the apparatus does not limit apparatus claims. See MPEP 2115. Thus, any apparatus which aligns reads on claim 1.

With respect to claims 2 & 11, Tsurumaki discloses a layer 86 which inhibits slipping. C7/L28-40.

With respect to claims 3-4, Tsurumaki discloses a compliant element 86, e.g. rubber. C7/L38-40.

With respect to claim 6, Tsurumaki discloses a contact surface (indicated generally as 86).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsurumaki in view of Vienneu (US 1,773,068).

With respect to claim 8, Tsurumaki does not disclose edge curves in a wave shape. Vienneu discloses curves in a wave shape (FIGS. 6-7) which improves on joint connections of two sheets of materials without increasing the thickness of each individual sheet. C1/L5-20. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Tsurumaki to include curves in a wave shape, as per the teachings of Vienneu, to increase joint strength without increasing material costs.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsurumaki in view of Schmitt (US 3,902,214).

With respect to claim 13, Tsurumaki discloses stacking and does not disclose an oil film. Schmitt discloses stacking pallets including a step of applying an oil film layer (C5/L1-7) which improves on stacking pallets by eliminating the noisy and damaging practice of dropping pallets. C1. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Tsurumaki to include applying an oil film layer, as per the teachings of Schmitt, to reduce noise during stacking and damage to steel pallets.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W. Adams whose telephone number is (571) 272-8101. The examiner can normally be reached on M-Th, 8:30am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saul Rodriguez can be reached on (571) 272-7097. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GWA

*Deey Adams*  
12/16/07